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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062400
Party	Defendant Avalon IP Holding Co.
Correspondence Address	LEE J EULGEN NEAL GERBER & EISENBERG LLP 2 N LASALLE ST SUITE 1700 CHICAGO, IL 60602 UNITED STATES knye@ngelaw.com, leulgen@ngelaw.com, temanuelson@ngelaw.com, dcesek@ngelaw.com, ECFDocket@ngelaw.com, mhoffman@ngelaw.com
Submission	Reply in Support of Motion
Filer's Name	Katherine Dennis Nye
Filer's e-mail	knye@ngelaw.com, leulgen@ngelaw.com, mhoffman@ngelaw.com, ecfdock- et@ngelaw.com
Signature	/Katherine Dennis Nye/
Date	07/28/2016
Attachments	Reply in Support of Motion to Extend_.pdf(429652 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AvalonBay Communities, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92062400
)	
Avalon IP Holding Co., LLC,)	
)	
Registrant.)	

PETITIONER’S REPLY IN SUPPORT OF MOTION FOR EXTENSION OF TIME

Petitioner’s Opposition to Registrant’s Motion for Extension of Time does not, and indeed cannot, undermine Registrant’s showing of good cause necessary to grant an extension in this matter. Accordingly, Registrant again respectfully requests that its Motion be granted, and a sixty day extension of all deadlines entered.

The standard for granting an extension of time is good cause. Fed. R. Civ. P. 6(b)(1); TBMP §509. “The Board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.” *Jodi Kristopher Inc. v. International Seaway Trading Corp.*, 88 USPQ2d 1798, 1800 (TTAB 2008) (granting unconsented motion for extension of time); citing *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

Here, the parties agree on at least one fact: the parties have been actively engaged in discovery up to this point. (Resp. Br.¹, p. 6.) The parties have exchanged written discovery requests and responses and objections, in addition to thousands of pages of documents. (*Id.* at

¹ References to Response Brief at to Petitioner’s Opposition to Motion for Extension of Time, 11 TTABVUE.

pp. 2-5.) This diligence shows that this motion is brought in order to complete discovery in an orderly and fulsome way, and that good cause is present. Furthermore, it shows that Registrant has not been guilty of negligence or bad faith.

Confoundingly, despite this record, Petitioner attempts to argue that Registrant has not diligently sought discovery during the discovery period. This is belied by Petitioner's own declaration and is in spite of the fact that Registrant was the first party to serve written discovery requests (Raimer Decl.,² ¶ 2), that Registrant promptly notified Petitioner of deficiencies in its responses to those requests (Raimer Decl., ¶ 7), and that Registrant has now filed a Motion to Compel documents and information (Raimer Decl., ¶ 23). These are not the actions of a party that is less than diligent.

The cases cited by Petitioner are wholly inapposite. In *National Football League v. DNH Management LLC*, the movant argued that good cause was shown because the parties were engaged in settlement discussions. 85 USPQ2d 1852, 1854 (TTAB 2008). However, the record evidence showed that there had been no settlement correspondence at all for over two months, and that the applicant never responded to opposers' settlement communications. *Id.* Despite that, opposers did not serve any discovery requests at all for an additional three months, a mere two days before the discovery period was set to close. *Id.* In that case, the Board held that "opposers knew or should have known that settlement or even legitimate talk of settlement was highly unlikely. In these circumstances, opposers could not have reasonably concluded that they need not move forward and serve requests for discovery. Clearly, the opposers' claimed need for an extension of discovery is the product solely of opposers' unwarranted delay in initiating discovery." *Id.* at 1854-1855. Similarly, in the other case relied upon by Petitioner, *Luemme*

² References to Raimer Decl. are to the Declaration of Anna E. Raimer In Support of Registrant's Opposition to Petitioner's Motion for Extension, 11 TTABVUE.

Inc. v. D.B. Plus Inc., the petitioner waited six months, until the last day of the discovery period, to serve any discovery requests. 53 USPQ2d 1758, 1761 (TTAB 1999). By contrast, here, as detailed above and in Petitioner's own response brief, Registrant has been diligent in pursuing discovery.

The additional fact that only one Motion to Extend has previously been filed in this matter, in November 2015, for an extension of thirty days, shows that the privilege of extensions in this matter has not been abused. *See American Vitamin Prods.*, 22 USPQ2d at 1314. Indeed, Petitioner's own letter proves this point:

[Petitioner] is willing to agree to the proposed 60-day extension. However, such consent is dependent on [Registrant's] agreement that no further extensions of the new deadlines will be requested or observed except by further agreement of the parties in this proceeding. Please confirm your agreement to these terms.

(Raimer Decl., Ex. 1.) That is, Petitioner apparently agreed that this extension was proper, but in exchange for its agreement to it, wanted Registrant to agree that it would never file an unconsented motion for extension, without knowing how much additional discovery might be necessary in light of the parties' ongoing discovery disputes, and no depositions having been taken. This shows Petitioner's motivation in opposing this motion is mere gamesmanship.

In any event, the parties' ongoing discovery disputes are in fact good cause for an extension. Presumably, if and when this Board orders Petitioner to fully respond to Registrant's discovery requests as set forth in Registrant's Motion to Compel, Petitioner will require some time to comply with that order. Then, is not clear what, if any, follow up discovery may be necessary after Petitioner is able to review and analyze that information. In addition, neither party has yet taken a deposition in this case, which frequently leads to additional necessary follow up.

As noted in Petitioner's response, Petitioner has served deposition notices for two of Registrant's key executives, as well as its corporate representative(s) pursuant to Rule 30(b)(6). (Raimer Decl., Ex. 2.) These notices, attempting to schedule depositions for a holiday week, were served 11 business days before the operative dates. (*Id.*) Registrant's counsel promptly advised Petitioner that the witnesses were not available during that timeframe, and committed to finding available alternative dates. (Raimer Decl., Ex. 3.) In due course, Registrant provided dates that were convenient for both the witnesses and counsel (Raimer Decl., Ex. 7), and promptly received a letter response with thanks, and confirming those dates. (Declaration of Katherine Nye, attached hereto, at Ex. A.) This letter, omitted from the Declaration of Anna E. Raimer and its Exhibits, belies any implication that this exchange, and attempt to find available dates with the intervening busy vacation season, is anything but routine.

Opposer has failed to establish any reason to believe it would be prejudiced by this extension. Additional time for discovery does not constitute prejudice. *See, e.g., Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702-1703 (TTAB 2002) ("...we have held before that the mere passage of time is generally not considered prejudicial, absent the presence of other facts, such as the loss of potential witnesses.") Petitioner scapegoats Registrant for the scope of this case, but Petitioner is the party that brought this action, and its pleadings define the scope. Petitioner bemoans its "near 3,000-person organization spread out throughout communities across the U.S." and contrasts it with Registrant's reasonably small size. (Resp. Br. p. 9-10.) What these facts actually show, however, is that Petitioner, a large company with enormous resources, should not be permitted to steamroll the Registrant here by means of attempting to cut off the discovery period before Registrant is adequately able to develop its case.

Petitioner attempts to evade normal discovery by arguing that Registrant should have no time to take depositions at all. However, the discovery period had not yet closed when the instant Motion and Registrant's Motion to Compel were contemporaneously filed. (5-8 TTABVUE.) By rule, a Motion to Compel will suspend a case with respect to all matters not germane to the Motion, which in this case, would include any possible depositions. *See* Trademark Rule §2.120(e). Registrant has not noticed any depositions because what witnesses should be deposed and the nature and scope of their depositions will necessarily depend upon the documents that Registrant seeks in its Motion to Compel. Accordingly, an extension of time is appropriate.

WHEREFORE, Applicant respectfully requests that the Board grant this motion for a sixty-day extension of all remaining deadlines in these proceedings.

Dated: July 28, 2016

By: /Katherine Dennis Nye/
One of the Attorneys for Registrant,
Avalon IP Holding Co., LLC

Lee J. Eulgen
Katherine Dennis Nye
Neal Gerber & Eisenberg LLP
2 N LaSalle St Suite 1700
Chicago, Illinois 60602
(312) 269-8000

CERTIFICATE OF SERVICE

I, Katherine Dennis Nye, an attorney, state that I served a copy of the foregoing Reply in Support of Motion for Extension of Time on:

Brent D. Sokol
JONES DAY
555 S. Flower Street, 50th Floor
Los Angeles, CA 90071

Anna Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, TX 77002

via U.S. mail on July 28, 2016, with a courtesy copy via email.

/Katherine Dennis Nye/
Katherine Dennis Nye

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AvalonBay Communities, Inc.,)	
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Petitioner,)	
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v.)	Cancellation No. 92062400
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Avalon IP Holding Co., LLC,)	
)	
Registrant.)	

**DECLARATION OF KATHERINE DENNIS NYE IN SUPPORT OF
MOTION TO EXTEND**

I, Katherine Dennis Nye, an attorney, state that, if called to testify as a witness in this matter, I could competently testify as follows:

1. I am licensed to practice law in the State of Illinois. I am an associate at the law firm Neal, Gerber & Eisenberg LLP, and serve as counsel to Registrant Avalon IP Holding Co., LLC in the above-captioned matter.

2. On July 8, 2016, counsel for Petitioner, Meredith Williams, sent a letter to me, confirming the depositions of Registrants 30(b)(6) designee(s) and two of its employees for September 13-15, 2016. A true and correct copy of this letter is attached hereto as Exhibit A.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct.

Dated: July 28, 2016



Katherine Dennis Nye

Exhibit A

JONES DAY

3161 MICHELSON DRIVE • SUITE 800 • IRVINE, CALIFORNIA 92612-4408
TELEPHONE: +1.949.851.3939 • FACSIMILE: +1.949.553.7539

Direct Number: (949) 553-7529
MWilliams@JonesDay.com

July 8, 2016

VIA EMAIL (KNYE@NGELAW.COM)

Katherine Dennis Nye
Neal, Gerber & Eisenberg LLP
2 N. LaSalle St., Suite 1700
Chicago, IL 60602

Re: AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC,
Cancellation No. 92062400

Dear Ms. Nye:

Thank you for your email dated July 7, 2016, confirming Avalon IP's witnesses will be available September 13-15, 2016. The depositions will take place in the noticed order with the same timing and location, with Avalon IP's 30(b)(6) designee(s) on Tuesday, September 13, Mr. Korzen on Wednesday, September 14, and Mr. De Lowe on Thursday, September 15.

If you have any questions, please do not hesitate to contact me.

Sincerely,



Meredith L. Williams